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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,877	08/04/2003	Ron L. Hale	00059.01R	5255
37485 7590 09/25/2007 SWANSON & BRATSCHUN, L.L.C 8210 SOUTHPARK TERRACE LITTLETON, CO 80120			EXAMINER HAGHIGHATIAN, MINA	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,877

Applicant(s)

HALE ET AL.

Examiner

Mina Haghighatian

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/24/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-30 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartus et al (6,514,482) in view of Faithfull et al (6,041,777).

Bartus teaches a method of pulmonary delivery of a medicament, which includes administering to the pulmonary system and in particular to the alveoli or the deep lung particles comprising an effective amount of a medicament, where the particles preferably have an aerodynamic diameter between about 1 and about 5 μm . Particles can consist of the medicament or can further include one or more additional components. Rapid release of the medicament into blood stream and its delivery to its site of action (col. 3, lines 41-59).

Bartus discloses that medicaments which can be used in the said method include lorazepam, apomorphine, donapezil, buprenorphine hydrochloride, hydromorphone, butorphanol, nalbuphine, naltrexone, oxycodone, etc, (col. 6, lines 49-63).

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In a preferred embodiment, Bartus discloses that particles are delivered from an inhalation device, preferably they are administered via a dry powder inhaler (DPI), metered dose inhaler (MDI), nebulizers or instillation techniques. Various suitable devices and methods of inhalation which can be used are known in the art (col. 7, line 24 to col. 8, line 8).

Bartus discloses that at least 50% of the mass of the particles stored in the inhaler receptacle is delivered to a subject's respiratory system in a single breath activated step. Amounts of drug or medicament present in the particles can range from 1 to about 90 weight percent (col. 8, lines 26-41). Bartus lacks teachings on producing condensation aerosol and also lacks specific disclosure on the presence of less than 5% degradation products.

Faithfull teaches methods and apparatus for closed-circuit ventilation therapy. In procedures involving liquid ventilation, this treatment and recirculation of the exhaled gases, vapors or liquids substantially reduces the amount of respiratory promoter needed to provide effective ventilation (col. 10, lines 13-26). Faithfull discloses that the nebulizer is used to provide fluorochemicals, heated above body temperature, to the ventilating gas in the form of a vapor. This may be accomplished by spraying or contacting a wetted surface or wick with the gas to form droplets. The fluorochemical liquid medium is particularly well dispersed in the lungs. As the fluorochemical vapor cools in the body it is deposited on the pulmonary surfaces (col. 16, lines 44-67).

Faithfull also discloses that the said method provides for the independent delivery of pharmaceutical agents or their use in conjunction with other vapors (col. 25, lines 15-30).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the method of delivering a medicament to a patient's respiratory tract of Bartus, by adding the steps of heating the composition and having patient inhale the condensates, because of the disclosed benefits of such a method, including minimized trauma to the lungs and a better resolution of pulmonary and systemic disorders, as taught by Faithfull. Furthermore one of ordinary skill in the art would know that condensates have a high percentage of purity of the drug and less degradation products. Also noted that optimization of concentration ranges will not support patentability.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartus et al (6,514,482) in view of Byron et al (20040016427 A1).

Bartus, discussed above, lacks disclosure on condensation aerosols and the devices for producing condensates involved in the method of therapy.

Byron et al disclose a method and apparatus for generating an aerosol. The aerosol is formed by supplying a material in liquid form to a tube and heating the tube

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such that the material volatilizes and expands out of an open end of the tube. The volatilized material combines with ambient air such that volatilized material condenses to form the aerosol (see abstract and [0012]). The aerosols intended for inhalation typically have a mass median particle diameter of less than 2 microns (see [0074]).

Byron et al disclose that the apparatus may be fairly large or may be miniaturized to be hand held (see [0086]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have implemented the aerosol device article of Byron et al for delivering the aerosolized composition of Bartus to a subject's respiratory tract because it would be desirable to provide an aerosol delivery article which is capable of producing condensate aerosol particles of relatively small size without the necessity of subjecting the material to be aerosolized to exposure to a significant degree of heat or high temperatures. Also noted that optimization of concentration ranges will not support patentability.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-30** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent Nos. 6,776,978, 7,078,018 and 6,814,955. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims are either anticipated by, or would have been obvious over, the reference claims. Here claims **1-30** are generic to all that is recited in claims of cited U.S. Patents. That is, claims of cited U.S. Patents would have been obvious over instant claims **1-30**. Specifically, the article and the methods of preparing compositions of the instant claims would have been obvious over the compositions and methods of the cited U.S. Patents.

Claims **1-30** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent Nos. listed in the Table below. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims are either anticipated by, or would have

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been obvious over, the reference claims. Here claims **1-30** are generic to all that is recited in claims of cited U.S. Patents. That is, claims of cited U.S. Patents either fall entirely within the scope of claims **1-30**, or would have been obvious over the claims of the cited U.S. Patents. Specifically, the compositions for delivery and the methods of preparing the said compositions of the instant claims are the same as compositions and methods of the cited U.S. Patents. The difference between the said patents are the active agents recited in each application. It is held that the simple substitution of one known element for another would have yielded predictable results.

Claims **1-30** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent Nos. listed below. The said patents have been found to claim substantially similar subject matter per the obviousness-type double patenting rejections made above in the instant office action, especially with regards to compositions and methods of making drug condensation aerosols. Furthermore, it appears that the invention is the condensate compositions and the method of making them. Thus it is considered that the substitution of one known element for another does not alter the scope of the said claims and would have yielded predictable results.

U.S. Patent/Application Number	U.S. Patent/Application Number	U.S. Patent/Application Number	U.S. Patent/Application Number
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1. 6,805,853 (Patent)	27. 7,052,679 (Patent)	53. 7,078,020 (Patent)	79. 11/488,943 (Appl.)
2. 6,994,843 (Patent)	28. 7,033,575 (Patent)	54. 7,087,216 (Patent)	80. 11/500,736 (Appl.)
3. 6,780,399 (Patent)	29. 6,783,753 (Patent)	55. 7,087,217 (Patent)	81. 11/501,246 (Appl.)
4. 6,780,400 (Patent)	30. 7,011,820 (Patent)	56. 7,060,254 (Patent)	82. 11/670,892 (Appl.)
5. 6,716,415 (Patent)	31. 7,005,122 (Patent)	57. 7,070,763 (Patent)	83. 11/507,986 (Appl.)
6. 6,855,310 (Patent)	32. 7,048,909 (Patent)	58. 7,070,764 (Patent)	84. 7,070,765 (Patent)
7. 6,783,753 (Patent)	33. 7,060,254 (Patent)	59. 7,070,765 (Patent)	85. 6,737,046 (Patent)
8. 6,716,416 (Patent)	34. 7,045,119 (Patent)	60. 7,063,830 (Patent)	86. 7,090,830 (Patent)
9. 6,743,415 (Patent)	35. 7,018,621 (Patent)	61. 7,169,378 (Patent)	87. 11/500,735 (Appl.)
10. 6,737,042 (Patent)	36. 7,011,819 (Patent)	62. 7,067,114 (Patent)	88. 10/057,197 (Appl.)
11. 6,814,954 (Patent)	37. 7,014,840 (Patent)	63. 7,070,766 (Patent)	89. 10/146,086 (Appl.)
12. 6,884,408 (Patent)	38. 7,022,312 (Patent)	64. 7,063,831 (Patent)	90. 10/633,876 (Appl.)
13. 6,740,308 (Patent)	39. 7,014,841 (Patent)	65. 7,181,039 (Patent)	91. 10/633,877 (Appl.)
14. 6,776,978 (Patent)	40. 6,994,843 (Patent)	66. 7,087,218 (Patent)	92. 11/248,598 (Appl.)
15. 6,740,309 (Patent)	41. 7,008,616 (Patent)	67. 7,063,832 (Patent)	93. 11/370,628 (Appl.)
16. 6,814,955 (Patent)	42. 7,052,680 (Patent)	68. 6,797,259 (Patent)	94. 11/398,383 (Appl.)
17. 6,716,417 (Patent)	43. 7,078,016 (Patent)	69. 11/442,917 (Appl.)	95. 10/719,540 (Appl.)
18. 6,737,043 (Patent)	44. 10/437,643 (Appl.)	70. 11/451,852 (Appl.)	96. 10/057,198 (Appl.)
19. 6,759,029 (Patent)	45. 10/719,899 (Appl.)	71. 11/451,853 (Appl.)	97. 10/146,088 (Appl.)
20. 6,803,031 (Patent)	46. 7,070,761 (Patent)	72. 11/454,573 (Appl.)	98. 7,108,847 (Patent)
21. 6,805,854 (Patent)	47. 7,070,762 (Patent)	73. 11/479,361 (Appl.)	99. 7,078,016 (Patent)
22. 7,029,658 (Patent)	48. 7,115,250 (Patent)	74. 11/479,509 (Appl.)	100. 7,060,255 (Patent)
23. 7,008,615 (Patent)	49. 7,094,392 (Patent)	75. 11/479,892 (Appl.)	101. 11/523,685 (Appl.)
24. 7,018,619 (Patent)	50. 7,078,017 (Patent)	76. 11/481,279 (Appl.)	102. 11/439,475 (Appl.)
25. 7,005,121 (Patent)	51. 7,078,018 (Patent)	77. 11/488,302 (Appl.)	103. 11/621,397 (Appl.)
26. 7,045,118 (Patent)	52. 7,078,019 (Patent)	78. 11/488,932 (Appl.)	104. 10/696,959 (Appl.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 571-272-0615. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mina Haghighatian
September 20, 2007